

AMENDMENTS TO THE DRAWINGS:

The attached one (1) sheet of drawing includes changes to Fig. 18. This one sheet, which includes Fig. 18, replaces the original sheet including Fig. 18. In Fig. 18, the legend "PRIOR ART" has been added in accordance with the Examiner's stated requirement.

Attachment: 1 Replacement Sheet

REMARKS

I. Introduction

Claims 18-31 remain pending in the present application. Claims 18-21 and 26-31 have been withdrawn from consideration, so claims 22-25 are under consideration and have been rejected.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

II. Drawings

In response to the Examiner's drawing objection, Applicants are submitting herewith a replacement drawing sheet containing amended Fig. 18, in which the legend "PRIOR ART" has been added in accordance with the Examiner's stated requirement. Withdrawal of the drawing objection is respectfully requested.

III. Double Patenting

Claims 22-25 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 7,050,224. In order to facilitate expedited prosecution of the present application, Applicants are submitting herewith a Terminal Disclaimer under 37 C.F.R. § 1.321(c) to overcome the double patenting rejection based on U.S. Patent No. 7,050,224.

IV. Rejection of Claims 22-25 under 35 U.S.C. § 103(a)

Claims 22-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,809,859 ("Erdogan"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d

1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As clearly indicated by the Supreme Court, in order to sustain an obviousness rejection, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there must be some articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness.” *Id.*, at 1396.

Claim 22 recites, in relevant parts, that “an interval between a wavelength of the laser light and a half-value wavelength of the absorption filter on a short-wavelength side is within a width between 1nm to 12nm.” In support of the rejection, the Examiner contends that “Erdogan discloses the interval between the wavelength of the excitation filter 204 (fig 2) and a half-value wavelength of the absorption filter on a short-wavelength side in a range of 6-12nm (fig 6),” and that “[although] Erdogan does not explicitly disclose the interval between a wavelength of the laser light and a half-value wavelength of the absorption filter on a short-wavelength side is within a width between 1 nm to 12nm, . . . if the light source and the excitation filter of Erdogan are combined into a single unit, the claimed interval between the wavelength of the laser source and the absorption filter would have been obvious.” (Office Action, p. 5). However, as discussed in the telephone interview with the Examiner on November 5, 2007, it appears that the Examiner was inadvertently addressing the limitations of withdrawn claim 21 (“wherein the apparatus is incorporated in an optical system of an endoscope”). Erdogan reference clearly does not disclose the wavelength of the laser light, let alone the claimed feature of claim 22 that “an interval between a wavelength of the laser light and a half-value wavelength of the absorption filter on a short-wavelength side is within a width between 1 nm to 12 nm.” For at least this reason, claim 22 cannot be rendered obvious by Erdogan.

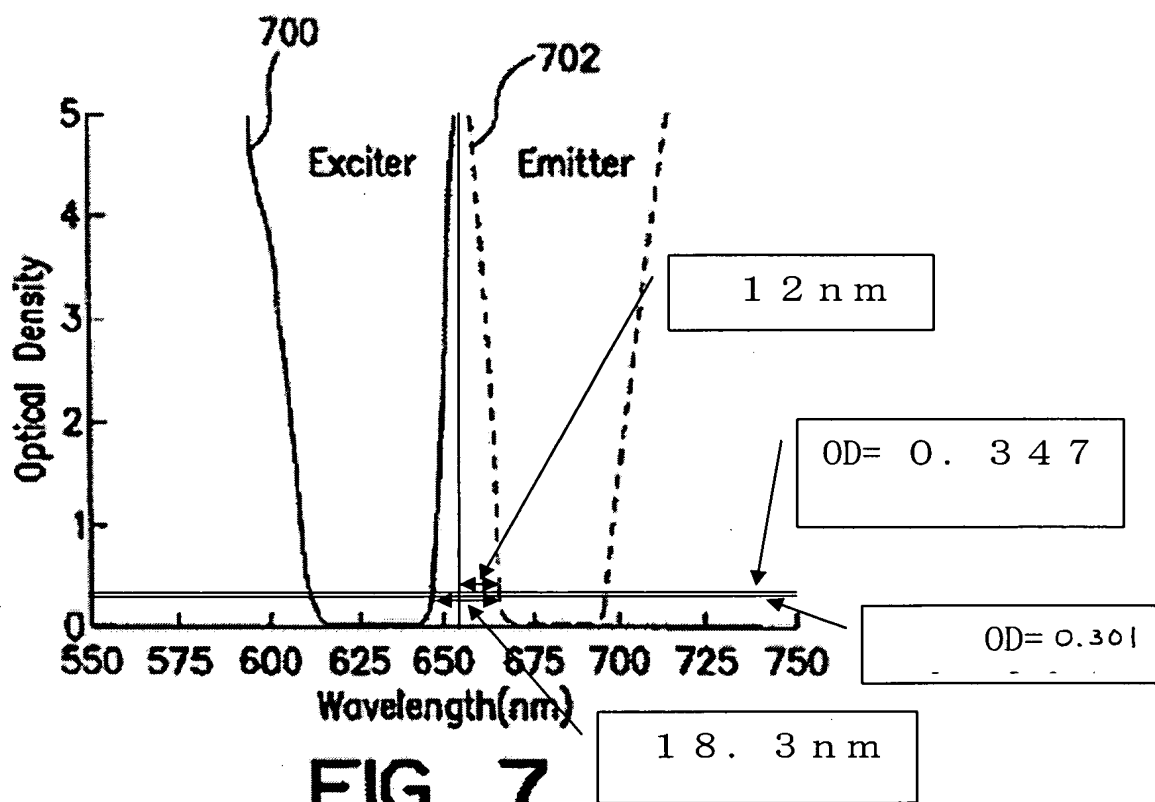
With respect to the Examiner's contention that **"if the light source and the excitation filter of Erdogan are combined into a single unit,"** the claimed interval between the wavelength of the laser source and the absorption filter would have been obvious," the examiner did not indicate any particular structure or arrangement for the alleged "single unit." Even if one applies the most favorable interpretation to the Examiner's contention, the Examiner's contention may be regarded as one in which the "single unit" is a mere combination of the light source and the excitation filter of Erdogan, where light emitted from the "single unit" is limited by the passband of the excitation filter. In addition, even if one assumes for the sake of argument that the combination of the light source and the excitation filter of Erdogan would be somehow comparable to the claimed laser light, there is simply no logical support for the Examiner's statement that "Erdogan discloses the interval between the wavelength of the excitation filter 204 (fig 2) and a half-value wavelength of the absorption filter on a short-wavelength side in a range of 6-12nm (fig 6)."

Although it is not clear precisely what point the examiner is trying to make by citing "the wavelength of the excitation filter 204" in Fig. 2 of Erdogan, for the purpose of finding an interval between a wavelength of illumination light (resulting from the combination of the light source and the excitation filter of Erdogan as asserted by the examiner) and a short-wavelength-side half-value wavelength of the absorption filter (and in order to compare the resulting value with the claimed range 1-12nm), it is necessary to identify a wavelength where the excitation filter passes sufficient amount of light for illumination, i.e., a wavelength in a range where transmittance is at least a half the maximum value should be taken for appropriate comparison. In this regard, since the passband of the absorption filter (emitter) 602 of Erdogan resides on the long wavelength side of the passband of the excitation filter (exciter) 600, the half-value wavelength of the excitation filter on the long wavelength would be appropriate for determining a minimum value of the interval between the illumination light and the half-value wavelength of the absorption filter on the short-wavelength side. However, FIG. 6 of Erdogan has a small scale and thus the half-value wavelength of the excitation filter 600 on the long wavelength side or the half-value wavelength of the absorption filter on the short wavelength side cannot be accurately known from the plotting.

Erdogan discloses that the exemplary excitation and emission filter constructions illustrated in Figs. 6 and 7 exhibit transmission that exceeds 90% over the passband (column 11, lines 54-56), i.e., the maximum transmission of each of the excitation filter and the emission

filter is in a range of 90-100%. Therefore, a half-value wavelength of each of the excitation filter and the emission filter resides somewhere between a wavelength where the transmission is 45% and a wavelength where the transmission is 50%. In addition, Erdogan further discloses that “the optical density (OD) is defined to be minus the logarithm (base 10) of the transmission” (column 6, lines 51-52). Thus, when transmission is 45%, optical density is approximately 0.3468; when transmission is 50%, optical density is approximately 0.3010. Accordingly, the half-value wavelength of each of the excitation filter and the emission filter of Erdogan resides somewhere between a wavelength where the optical density is 0.347 and a wavelength where the optical density is 0.301. For the sake of illustrative clarity, Applicants have added a straight line OD=0.347 and a straight light OD=0.301 to FIG. 7 of Erdogan, as shown below.

According to this figure, the interval between the half-value wavelength of the excitation filter



on the long-wavelength side and a half-value wavelength of the absorption filter on the short wavelength side is 18.3nm. As discussed above, since this can be regarded as a “minimum” interval between the illumination light and the half-value wavelength of the absorption filter, it

is quite clear that Erdogan fails to satisfy the claimed condition of claim 22, i.e., "an interval between a wavelength of the laser light and a half-value wavelength of the absorption filter on a short-wavelength side is within a width between 1nm to 12nm."

For at least the foregoing reasons, claim 22 and its dependent claims 23-25 are allowable over Erdogan.

V. Conclusion

For at least the foregoing reasons, it is respectfully submitted that all pending claims 22-25 under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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